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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,336	11/19/2001	Takaya Nonomura	042206	8557

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EXAMINER

CHOWDHURY, SUMAIYA A

ART UNIT PAPER NUMBER

2623

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/988,336

Applicant(s)

NONOMURA, TAKAYA

Examiner

Sumaiya A. Chowdhury

Art Unit

2623

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 11-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 11-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Arguments

1. Applicant's arguments filed 4/4/06 have been fully considered but they are not persuasive.

(a) Applicant argues "Iggulden does not disclose or suggest ... a commercial" on page 16, 2nd paragraph of the amendment filed 4/4/06.

In response, the Examiner disagrees with the Applicant. Iggulden teaches that when a commercial is detected, a screen presenting an appropriate logo (advertising information) such as the tradename or trademark of the system is displayed (See col. 25, lines 5-23).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Iggulden does teach that the advertising information (logo) which is selected by the system is feed to the video/audio output means when a commercial appended to a program is detected (See col. 25, lines 5-23, col. 8, lines 55-65, lines 28-35).

2. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thibadeau (5565909) in view of Iggulden (6002443).

As for claim 1, Thibadeau discloses a digital broadcasting receiving device with an advertising information outputting function, comprising:

a receiver for receiving a digital broadcasting wave - col. 7, lines 35-51, col. 5, lines 28-40;

video/audio output means (television) for outputting at least one of video and audio (The television outputs the TV program on the display screen);

means (data processor) for taking out advertising information and advertising area information which are carried on the digital broadcasting wave – col. 11, lines 32-47, col. 20, lines 55-60, col. 8, lines 8-12;

means (either user or gps) for outputting information related to the current position – (The user could manually enter in location data, or the location data could be received by use of a dynamic GPS; col. 20, lines 29-67);

selection means (processor) for selecting the advertising information by the

contrast between the information related to the current position and the advertising area information – col. 20, lines 55-60, col. 11, lines 32-47, col. 13, lines 49-53, col. 10, lines 30-35; and

a controller (component within receiver) for feeding the selected advertising information to said video/audio output means at predetermined timing – (The advertisements are stored for later retrieval - col. 14, lines 43-53).

However, Thibadeau fails to disclose in the digital broadcasting receiving device with an advertising information outputting function, a digital broadcasting receiving device with an advertising information outputting function, comprising

judgment means for judging whether or not video and audio which are being currently outputted are a commercial (CM) appended to a program,

wherein said controller feeds to said video/audio output means the advertising information selected when said judgment means judges that the video and audio which are currently being outputted are a commercial.

In an analogous art, Iggulden discloses wherein the system comprises of judgement means (108 – Fig. 1) which detects whether or not commercials are appended to a program (col. 8, lines 55-65, lines 28-35). When it does detect that commercials are appended to a program in a broadcast signal, the system outputs a screen (television) presenting an appropriate logo (alternative advertisement information) representative of the commercial determination system such as the tradename or trademark of the system –col. 25, lines 5-23, col. 8, lines 55-65.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Thibadeau's invention to include wherein the system detects advertisements which are appended to a program in a broadcast signal, the system outputs alternative audio/video information (advertising information), as taught by Iggulden, for the advantage of substituting undesirable advertisements to the user.

As for claim 2, Thibadeau discloses a digital broadcasting receiving device with an advertising information outputting function, comprising:

- a first receiver (STB) for receiving a digital broadcasting wave – col. 7, lines 35-51, col. 5, lines 28-40;

- video/audio output means for outputting at least one of video and audio;
- means for taking out advertising information and advertising area information which are carried on the digital broadcasting wave – col. 11, lines 32-47, col. 20, lines 55-60, col. 8, lines 8-12;

- a second receiver (data processor associated with the set-top unit) for receiving a transmission wave on which information required to specify the current position is carried – col. 10, lines 25-28, col. 20, lines 29-67, col. 9, lines 30-37;

- means for outputting information related to the current position on the basis of the information carried on said transmission wave – (The user could manually enter in location data, or the location data could be received by use of a dynamic GPS; col. 20, lines 29-67);

- selection means for selecting the advertising information by the contrast between

the information related to the current position and the advertising area information – col. 20, lines 55-60, col. 11, lines 32-47, col. 13, lines 49-53, col. 10, lines 30-35; and

a controller (component in STB that does the processing) for feeding the selected advertising information to said video/audio output means at predetermined timing – (The advertising information is stored for later retrieval - col. 14, lines 43-53).

However, Thibadeau fails to disclose in the digital broadcasting receiving device with an advertising information outputting function, a digital broadcasting receiving device with an advertising information outputting function, comprising

judgment means for judging whether or not video and audio which are being currently outputted are a commercial (CM) appended to a program,

wherein said controller feeds to said video/audio output means the advertising information selected when said judgment means judges that the video and audio which are currently being outputted are a commercial.

In an analogous art, Iggulden discloses wherein the system comprises of judgement means (108 – Fig. 1) which detects whether or not commercials are appended to a program. When it does detect that commercials are appended to a program in a broadcast signal, the system outputs a screen presenting an appropriate logo (alternative advertisement information) representative of the commercial determination system such as the tradename or trademark of the system – col. 8, lines 55-65, col. 25, lines 5-23, col. 8, lines 30-35.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Thibadeau's invention to include wherein the system

detects advertisements which are appended to a program in a broadcast signal, the system outputs alternative audio/video information (advertising information), as taught by Iggulden, for the advantage of substituting undesirable advertisements to the user.

As for claims 3 and 4, Thibadeau and Iggulden disclose the claimed limitations. In particular, Thibadeau discloses in the digital broadcasting receiving device with an advertising information outputting function, a digital broadcasting receiving device with an advertising information outputting function, comprising:

a memory storing the advertising information and the advertising area information which are taken out of the digital broadcasting wave – col. 13, lines 34-50, col. 14, lines 17-21, lines 28-31, lines 43-45, lines 52, col. 4, lines 51-54;

said selection means being constructed such that the advertising information stored in said memory can be selected by the contrast between the information related to the current position and the advertising area information – col. 20, lines 55-60, col. 11, lines 32-47, col. 13, lines 49-53, col. 10, lines 30-35;

Claim 5 contains the limitations of claims 1 and 3, and is analyzed as previously discussed with respect to that claim.

5. Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thibadeau and Iggulden as applied to claims 1-5 above, and further in view of Eldering (US 2002/0178445).

As for claims 11-15, Thibadeau and Iggulden fail to disclose in the digital broadcasting receiving device with an advertising information outputting function, a digital broadcasting receiving device with an advertising information outputting function, wherein

said controller feeds the advertising information selected by said selection means directly to said video/audio output means in response to the selection.

In an analogous art, Eldering discloses wherein upon selection of advertisements by a user, the advertisements are displayed immediately for the advantage of providing the convenience of displaying selected content when selected since the user desires to view it at that moment rather than later – paragraph [0093]

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Thibadeau and Iggulden's invention to include discloses wherein upon selection of advertisements by a user, the advertisements are displayed immediately, as taught by Eldering, for the advantage of providing the convenience of displaying selected content when selected since the user desires to view it at that moment rather than later.

6. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thibadeau and Iggulden as applied to claims 1-5 above, and further in view of Wright (33808).

As for claims 16-20, Thibadeau and Iggulden fail to disclose in the digital broadcasting receiving device with an advertising information outputting function, a digital broadcasting receiving device with an advertising information outputting function, wherein

said controller is so constructed as to feed the advertising information selected in said selection means to said video/audio output means when a signal representing the timing of outputting the advertising information is received.

In an analogous art, Wright discloses wherein a signal representing the timing of outputting the substitute program signals (advertising information) is received and outputted at the directed time for the advantage of allowing the advertiser to have their commercial displayed at a desired time.— col. 7, lines 10-24, col. 6, lines 40-42.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Thibadeau and Iggulden's invention to include wherein a signal representing the timing of outputting the substitute program signals is received and outputted at the directed time, as taught by Wright, for the advantage of allowing the advertiser to have their commercial displayed at a desired time.

7. Claims 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thibadeau and Iggulden, as applied to claims 1-5 above, and further in view of Zigmond (6698020).

As for claims 21-25, Thibadeau and Iggulden fail to disclose in the digital broadcasting receiving device with an advertising information outputting function, a digital broadcasting receiving device with an advertising information outputting function, comprising:

message output means (television) for outputting a message indicating that the advertising information exists,

said controller feeds the advertising information selected by the selection means to the video/output means in response to an advertising output operation performed by a user.

In an analogous art, Zigmond discloses wherein two or more advertisements (menu; displays that advertising information exists) are displayed to the user from which the user selects one advertisement using the remote control (selection means) to be displayed on the television (video/output means) – col. 16, line 65 – col. 17, line 10.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Thibadeau and Iggulden's invention to include wherein two or more advertisements (menu; displays that advertising information exists) are displayed to the user from which the user could choose one advertisement, as taught by Zigmond, for the advantage of informing the user the advertisements exists and so that the user could choose to watch desired content.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumaiya A. Chowdhury whose telephone number is (571) 272-8567. The examiner can normally be reached on Mon-Fri, 9-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SAC


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